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IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No. 73-1164

DEERING MILLIKEN RESEARCH CORPORATION, *Petitioner*

v.

THE DUPLAN CORPORATION, ET AL., *Respondents*

RESPONDENTS' OPPOSITION TO THE PETITION FOR A WRIT OF CERTIORARI

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INDEX

	Page
QUESTION PRESENTED	2
STATUTE INVOLVED	2
STATEMENT OF THE CASE	3
SUPPLEMENTAL STATEMENT OF FACTS	4
Chavanoz & DMRC Deliberately Delayed Filing The Applications In The United States	5
On the French "Délivré" Date Chavanoz Had Its Exclusive Right And Monopoly	6
Chavanoz Was Not Required To Keep The French Patents Secret	7
ARGUMENT	7
The Decisions Of The Courts Below Are Consistent With The Statutory Construction By The Patent Office And With The Prior Rulings Of The Federal Courts In Cases Arising Under Section 102(d) And Its Predecessors; There Is No Conflict	7
The Interpretation of Section 102(d) By The Patent Office, and By Patent Office Appellate Rulings, Have Uniformly Rejected "Publication" As A Requirement of Section 102(d)	8
Decisions of the Federal Courts Uniformly Hold That It Is Receipt of the "Exclusive Privilege", Rather Than "Availability to the Public", That Determines When An Invention Is "Patented" Under Section 102(d) And Its Predecessors	12
Congressional Policy Considerations Underlying Section 102(d) Differ From Those Underlying 102 (a) and (b)	18
CONCLUSION	21
APPENDIX	B1

TABLE OF AUTHORITIES

CASES: Page

American Infra-Red Radiant Co. v. Lambert Industries, Inc., 360 F.2d 977 (8th Cir.), *cert. denied*, 385 U.S. 920 (1966) 18
Atlas Glass Co. v. Simonds Mfg. Co., 102 Fed. 643 (3rd Cir., 1900) 17
The Bate Refrigerating Co. v. Sulzberger, 157 U.S. 1, 15 S.Ct. 508, 39 L.Ed. 601 (1895) 19
Brooks v. Norcross, 4 F.Cas. 294 (No. 1,957) (C.C.D. Mass. 1851) 10
DeFlorez et al. v. Raynolds et al., 8 Fed. 434 (C.C.S.D.N.Y., 1880) 15, 16
Ex parte Einfalt, 67 C.D. 59, 155 USPQ 529 (Patent Office Board of Appeals, 1966) 10,12
In re Ekenstam, 256 F.2d 321 (C.C.P.A., 1958) 10, 13
G. B. Lewis Co. v. Gould Products, Inc., 297 F.Supp. 690 (E.D.N.Y., 1968) *aff'd* 436 F.2d 1176 (2nd Cir., 1971) 17, 18
Gramme Electrical Company v. Arnouxi & Hochhausen Electric Co., 17 Fed. 838 (C.C.S.D.N.Y., 1883) ...16, 17
Ex parte Gruschwitz, 138 USPQ 505 (Patent Office Board of Appeals, 1961) 9, 10, 11
Ex parte Rackham, 306 O.G. 243 (1922) 11
Ritter v. Rohm & Haas Co., 271 F.Supp. 313 (S.D.N.Y., 1967) 18
In re Talbott, 443 F.2d 1397 (C.C.P.A. 1971) ..12, 13,14, 17
Ex parte Weiss, 159 U.S.P.Q. 122 (Patent Office Board of Appeals, 1967) 10, 11, 12, 13, 14

STATUTES AND REGULATIONS:

35 U.S.C. § 102 .....*passim*
35 U.S.C. § 151 6
Revised Statutes § 4886 14
Revised Statutes § 4887 .....15, 17, 19
37 C.F.R. 1.303 6

MISCELLANEOUS:

Manual of Patent Examining Procedure (MPEP) 8, 9

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The respondents, seventeen parties to the consolidated actions below (hereinafter collectively referred to as "Throwsters"), submit that the Petition for Writ of Certiorari should be denied.

The decisions of the lower courts present no "new" interpretation of the statute (35 USC 102(d)) involved; no change in the established law; no conflict between various circuits; and no threat to the proper

administration of the United States patent system. There are, therefore, no special or important reasons for this Court to review these decisions on certiorari.

QUESTION PRESENTED

The sole "question presented" by petitioner (hereinafter "DMRC") is fictitious, misleading and finds no foundation in either the record facts or the conclusions of law drawn by the two courts below. The "question" can be accurately stated as follows:

> Did the courts below err in holding that, when an applicant for United States patent has been vested with his full exclusive right under French patent law by official decree, his invention has been "patented or caused to be patented" in France within the meaning of 35 USC Section 102(d)?

STATUTE INVOLVED

The statute upon which both the district court and the court of appeals predicated their decisions is 35 USC Section 102(d) which read as follows:

> "A person shall be entitled to a patent unless—
> (d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States,"

This section is concerned with acts of the patent applicant and imposes a definite time limit for filing in the U. S., where the invention was previously patented abroad *by the same applicant* under the conditions specified. This is the only portion of section 102

which refers to prior patenting of the same invention by the same inventor.[1]

STATEMENT OF THE CASE[2]

The question and statement of facts, as framed by petitioner, suggest that petitioner is merely the innocent victim of an unexpected and novel interpretation of the applicable statute by the courts below. Nothing could be further from the truth.

Petitioner deliberately delayed the filing of the U. S. patent application, contrary to the intent of the statute. The oath accompanying the U.S. application was falsified and the Patent Office was thereby prevented from discovering the invalidating violation. Issuance and publication of the French patent were *purposefully* delayed at the patentee's *request*. The construction that the district court and the court of appeals applied to section 102(d) was not new or different. It was in fact the very same construction uniformly given to this provision and its predecessors by the Patent Office *and* the Federal Courts continuously from at least 1880 up until the present date.

Briefly stated, the courts below held that the same inventions, as claimed in two United States patents,

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[1] Petitioner, however, seeks to confuse the clear meaning and purpose of section 102(d) with that of separate and independent sections 102(a) and 102(b). Petitioner thus urges that the word "patented" be considered apart from its respective contexts, in disregard of the separate and distinct Congressional purposes and policies which underlie those different sections.

[2] The primary arguments in the courts below centered around U.S. patent 3,282,656 (and its counter-part French patent 1,427,001), with the understanding that the same legal conclusions and result would be applicable to U.S. patent 3,137,119. The same format will be followed in this Court.

had been "first patented or caused to be patented" by the same applicant in France "prior to the date of the application for patent in this country on an application filed more than 12 months before the filing of the application in the United States".[3] The patents are therefore invalid by reason of 35 USC 102(d).

It was never disputed by the petitioner that:

1. Each of the corresponding French patents was granted on an application filed more than 12 months before the filing of the respective application in the United States; and

2. Each of the corresponding French patents was granted (*délivré*) by a decree of the French Minister to the French patentee prior to the filing of the respective application in the United States.

SUPPLEMENTAL STATEMENT OF FACTS

Petitioner's statement obscures the facts—crucial to application of section 102(d)—that the invalidated U. S. patents are for the *same* invention as corresponding French patents previously obtained for the *same* patentees, the Crouzets, by the *same* assignee, Chavanoz.

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[3] As noted by the court of appeals (A2-3), the district court's decision was based upon unusual expertise. In extensive deposition proceedings, the district court had the opportunity to examine thousands of documents and to become thoroughly acquainted with the technical subject matter in question as well as the patent policies and procedures both in France and in the United States. The proceedings included examination of a French "Conseil en Brevets" (Mr. Laurent) who acted for the French parties, study of extensive affidavits relating to French patent procedure, the nature of a French patent, and the role of the French patent advisors. They also included special depositions taken in Paris, France, and a visit by the court to the French Patent Office.

Henri and Charles Crouzet, the named inventors of the respective United States patents in issue, are respectively the President and Director General of a French machinery manufacturing company, Ateliers Roannais de Constructions Textiles ("ARCT-France"). They assigned their inventions and applications to Moulinage et Retorderie de Chavanoz ("Chavanoz") retaining an exclusive license to manufacture and sell machines allegedly embodying the inventions.

Leo Soep was a French patent advisor, "Conseil en Brevets d'Invention", who acted from time to time for Chavanoz and for ARCT-France.

Petitioner DMRC obtained from Chavanoz merely the limited right to license the use of the inventions in the United States. Chavanoz, the owner of the patents, is a party to the proceedings in the district court, and is bound by the decision entered therein, but Chavanoz did not appeal from the judgment holding its patents invalid.

Chavanoz & DMRC Deliberately Delayed Filing the Applications in the United States

The documented origin of U.S. Patent No. 3,382,656 begins with the filing of the corresponding application in France on November 13, 1964 [Exhibit 957, B11].[4] On the 16th of November, 1964, Mr. Leo Soep wrote Mr. Crouzet advising him of the filing and enclosing a copy of the text as filed. [Exhibit 957A, B27].

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[4] Pages preceded by "B" are to Respondents' Supplemental Appendix, bound herewith. Pages preceded by "A" are to Petitioner's Appendix.

On December 8, 1964, Mr. Soep wrote to DMRC enclosing a translation of the French application and specifically requesting that DMRC postpone the filing of the corresponding United States application until the end of the priority period. [Exhibit 952, B29]. DMRC acknowledged this request and recognized the need to file in the United States prior to November 13, 1965 [Exhibit 953, B30]. However, the United States application was not filed until January 3, 1966, and its oath made no mention of the earlier filed corresponding French application. No documentation, excuse or reason has been produced for the deliberate delay in filing the United States application until after the grant of the corresponding French Patent No. 1,427,001 on December 27, 1965, or for the failure of DMRC-Chavanoz to reveal the existence of the French application to the United States Patent Office.

On the French "Délivré" Date Chavanoz Had Its Exclusive Right and Monopoly

DMRC does not contest that under French law, the inventor-patentee acquired all of the rights conferred by a patent on the *"délivré"* date.[5] On that date, the

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[5] DMRC's attempt (Petition p. 5) to equate the French *"délivré"* with the United States "notice of allowance" is specious. A "notice of allowance" (35 USC 151) merely sets the time running for paying a fee; if not paid by the applicant within the time allowed, no patent will issue. Moreover, the "notice" confers no rights, liability by an infringer cannot accrue, no suits can be filed, and the notice of allowance can be subsequently withdrawn by the Patent Office (37 C.F.R. 1.313), and the patent refused.

In contrast, on the day of *"délivré,"* the French applicant receives the following statement from the French Patent Office:

> ". . . the patent you have applied for . . . *has just been issued to you,* as per decree under today's date . . ." (B24),

and thereby acquires his full right to sue and recover for infringement. (A14-15; A17).

French Ministry signed the decree of issuance cr grant of the patent, and the inventor-patentee thereafter could sell, trade, publish, enforce, sue for infringement, or otherwise do as he wished. [A14, 15]. The subsequent publication in no way enlarged or changed the exclusive rights which vested and were enforceable on the *"délivré"* date.

Chavanoz Was Not Required To Keep the French Patents Secret

Contrary to the assertion in DMRC's petition, there was no requirement that Chavanoz keep the contents of the French patents secret after the *"délivré"* date. Even prior to the *"délivré"* date, Chavanoz had the full right to use and disclose the invention (as it did in fact disclose to DMRC, B29) as well as the right to apply for corresponding patents in other countries. [Laurent Testimony, B2 to 10].

ARGUMENT

THE DECISIONS OF THE COURTS BELOW ARE CONSISTENT WITH THE STATUTORY CONSTRUCTION BY THE PATENT OFFICE AND WITH THE PRIOR RULINGS OF THE FEDERAL COURTS IN CASES ARISING UNDER SECTION 102(d) AND ITS PREDECESSORS; THERE IS NO CONFLICT

The decisions of the courts below, holding that under French procedure *" 'délivré'* is the operative patent date" for purposes of Section 102(d), are entirely correct and completely supported by:

1. The uniform unbroken practice and rulings of the U.S. Patent Office, interpreting subsection 102(d);

2. A long and unbroken line of Federal Court decisions applying and interpreting section 102(d) and its predecessor statutes; and

3. The Congressional intent and policy which is embodied in subsection 102(d), which policy has been repeatedly held to be different from the policy embodied in subsections 102(a) and (b).

DMRC's sole line of argument is that the word "patented" must be narrowly construed, without regard to context or purpose, to always include "availability to the public". DMRC has thus ignored the fundamental aspect of a patent with which 102(d) is concerned—the exclusive monopoly granted to the patentee. Section 102(d) is concerned with the patent applicant, his acts and with limitations on his right to a monopoly in the United States when he has previously obtained a monopoly in a foreign country. "Availability to the public" is not and never has been a concern of section 102(d).

The Interpretation of Section 102(d) by the Patent Office, and by Patent Office Appellate Rulings, Have Uniformly Rejected "Publication" as a Requirement of Section 102(d).

The "Manual of Patent Examining Procedure" (hereinafter "MPEP") states the official policy and practice of the Patent Office in the treatment and examination of applications for United States patents.

Section 706.03(s) of the MPEP, entitled "Statutory Bar" succinctly states the Patent Office's established interpretation and the conditions which, if met, establish a "bar" under section 102(d), [B1] The condition which is pertinent to the issue here, that of when the invention is patented abroad, is explained in the MPEP in the following paragraph:

> "(3) The foreign patent must be actually granted (e.g., by sealing of the papers in Great Britain) before the filing in the United States or, since

> foreign procedures differ, the act from which it can be said that the invention was patented, has occurred. It need not be published. *Ex parte Gruschwitz et al,* 138 USPQ 505 discusses the meaning of 'patented' as applied to German procedures."

The decision of *Ex parte Gruschwitz,* cited in the MPEP, *supra,* is reported only at 138 USPQ 505 (Patent Office Board of Appeals, 1961). That decision was specifically concerned with the date on which a German patent should be considered "patented" for purposes of 102(d). The rationale employed by the Board directly contradicts the arguments presented by DMRC. The Board stated:

> ". . . [A]ppellants do not and cannot deny that the patent rights were legally in existence, were vested to the fullest extent that patent rights become vested in Germany, and were enforceable, at the time. The position taken is essentially that a later date, namely April 11, 1958, when the specification of the patent, identified as such, was issued in printed form, should be taken as the date the invention was patented in Germany. This position cannot be accepted. It is elementary and requires no citation of authority that the mere issuance of the specification of a patent in printed form is unessential to the question of whether an invention has been patented in a foreign country." (138 USPQ at 506)

Of even more direct application is the rule stated by the Board in *Gruschwitz* with respect to determining the date on which a French invention is "patented" in section 102(d):

> "In the case of France, a patent is granted (délivré) by the execution of a departmental order (or ministerial decree) which remains in

> the file, and the patentee notified of the fact. Some time later, about three months or so, the specification is issued in printed form. After that, in due course, the patentee is sent a patent document which consists of a certified copy of the granting order or decree with an attached copy of the specification. The practice of the U.S. Patent Office is and has been to consider the date the patent was granted (the 'délivré' date) as the date the patent was granted for the purpose of section 102, . . .". (138 USPQ at 510)

To the same effect, although again dealing with a German patent, is the decision of *Ex parte Weiss,* 159 USPQ 122 (Board of Appeals, 1967), which was extensively quoted in the Order of the district court, at A31 and A32. Most significantly, *Weiss* expressly considered *Brooks* v. *Norcross,* 4 F.Cas. 294, and *In re Ekenstam,* 256 F.2d. 321, two of the cases relied upon by DMRC, and held that those cases were not applicable to section 102(d).

In *Ex parte Einfalt,* 67 C.D. 59, 155 USPQ 529 (Board of Appeals, 1966) the argument that there must be both a grant by the foreign authorities and availability to the public to be "patented" within the meaning of 35 USC 102(d) was specifically rejected. The Board stated its reasons at page 530 of that opinion:

> "It appears to us that where appellant has full knowledge of the content of the design registration which was acknowledged for purposes of his benefit, he cannot be heard to complain . . . Decisions dealing with the meaning of 'patented' in connection with establishing bars against persons not party to the foreign filed document do not appear to us to be controlling on the present case."

From these cases which do deal with section 102(d), it is manifestly clear that the Patent Office itself, which is charged by Congress with the duty to in-

terpret the patent statutes in the first instance, has consistently followed the rule that an invention has been "patented" in a foreign country at the time when

> ". . . the patent rights were legally in existence, were vested to the fullest extent that patent rights become vested in [the foreign country] and were enforceable . . ." (*Ex parte Gruschwitz, supra,* at page 506).

The only Patent Office decision cited by DMRC in support of its contrary contention is *Ex parte Rackham,* 306 O.G. 243 (1922). The *Rackham* decision was thoroughly distinguished by the Board in *Ex parte Weiss* on the fundamental ground that, in *Rackham,* the British patentee had *not* received his "exclusive privilege", and due to wartime secrecy conditions,

> ". . . the inventor or patentee himself was even forbidden from applying for a patent elsewhere or revealing the invention without special permission, and no infringement suits could be brought with respect to infringement before the secrecy was removed." (at 125 of 159 USPQ)

Ex parte Rackham, therefore, has no applicability to the present state of facts. Here, there is no contention that Chavanoz was under any duty to keep its invention secret or that infringement suits could not have been brought by the French patentee on the *délivré* date. Indeed, the district court expressly found that the French patentee had been granted and could enforce his "exclusive privilege" from the *délivré* date (A 17).

Decisions of the Federal Courts Uniformly Hold That It Is Receipt of the "Exclusive Privilege", Rather Than "Availability to the Public", That Determines When an Invention Is "Patented" Under Section 102(d) and Its Predecessors.

Decisions of the Federal Courts which have interpreted and applied section 102(d) and its predecessors are completely consistent with the Patent Office's interpretations considered in the previous section, and are also consistent with the opinion of the courts below.

In *In re Talbott,* 443 F.2d 1397 (CCPA 1971) the Court of Customs and Patent Appeals flatly rejected the contention that "availability to the public"—required under Section 102(a) and (b)—should also be read by implication into the requirements of Section 102(d). In so doing, the court specifically approved and confirmed the Patent Office's decisions in *Ex parte Weiss* and *Ex parte Einfalt, supra.*

The *Talbott* decision deals with, and disposes of, the very same argument now made by DMRC in the following passage:

> "As to his second point of contention, appellant strongly argues that an affirmance of the Board's decision here would . . . require a holding absolutely contrary to the logical premise 'that in law, carefully drafted, certain terms—such as the term 'patented'—must have the same meaning, particularly since neither the law nor its legislative history contains any statement to the contrary.' To this we can only reply that, while appellant's premise is desirable in the ideal, it is impractical in applying statutory provisions to cover circumstances which are very real but vastly different. The policy considerations underlying parts (b) and (d) of section 102, while overlapping to some extent, are not necessarily identical. As the Patent Offce has pointed out, considerations in the nature of those which obviously governed our decision in Ekenstam [a 102(a) and (b) case],

> *supra,* have no application here." (443 F.2d at 1399).

The court thus held:

> "We agree with the Board that 'it is sufficient if the inventor receives from the foreign country the exclusive privilege that its laws provide for.'" (443 F.2d at 1399).

DMRC attempts to distinguish *Talbott* as well as *Weiss* on the ground that the German patents therein were kept secret only at the direction of the patentee, whereas the patents here in issue were not made public by requirement of French law. The decisions in *Talbott* and *Weiss* expressly do not rest on this narrow ground.

In any event, petitioner's alleged distinction, that here the French specifications were withheld from the public "by the impartial operation of [French] law" and not ". . . by the voluntary choice of the patent applicant . . . ." (Petition, p. 11), is *demonstrably untrue.*

The French patents (e.g., for No. 1,427,001, see B11) show on their face [6] that granting and hence publication was postponed at the express request of Chavanoz. But for this delay, the patents undoubtedly would have been

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[6] By the phrase:

"Brevet d'invention dont la délivrance a été ajournée en exécution de l'article 11, § 7, de la loi du 5 juillet 1844 modifée par la loi du 7 avril 1902."

Translated:

"Patent of invention the granting of which has been postponed pursuant to article 11, paragraph 7 of the law of July 5, 1844 as amended by the law of April 7, 1902."

Article 11 of the French patent law (the law of April 7, 1902) is reprinted at appendix, page B19, together with an English translation. The provision for postponement of "délivrance" at the *request* of the applicant was also adverted to by the district court in its Opinion, at A12.

published, as well as granted, prior to the U.S. filing date. The request for postponement was made in the French application as follows:

> "The applicant requests:
>
> (a) the postponement to one year of the granting of its patent;" (Literal translation [7])

While this delay was, of course, authorized by article 11, section 7, of the French patent law then in force, the delay in publication came about, not by the "impartial" operation of French law, but, just as in *Talbott* and *Weiss,* by the patentee's *express request.*

The distinctions between section 102(d) and sections 102(a) and (b), so clearly explained by *Talbott, supra,* are not "new", but on the contrary are well-rooted and recognized in prior decisions.

In sections 102(a) and (b) the term patented is used in context with the words "or described in a printed publication". The emphasis in these two sections is on knowledge available to the public. Knowledge or availability to the public was also the primary concern of their predecessor statute, R.S. 4886. [8]

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[7] French text at B18:

"Le deposant revendique(') :

(a) l'ajournement à un an de la délivrance de son brevet;"

[8] R.S. 4886: Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon the payment of the fees required by law, and other due proceedings had, obtain a patent therefor. [See prior patent statutes: Section 24, 1870; Sections 6 & 7, 1836; Section 1, 1800; Section 1, 1793.]

The word patented is used in section 102(d) in a different context. No reference is made to "known" or "described" or to a "publication". Clearly this section is concerned with the other aspect of a patent—the exclusive monopoly granted to the applicant. It is concerned only with what the applicant has patented, i.e., what exclusive monopoly rights the applicant has obtained in a foreign country. Its predecessor statute, R.S. 4887,[9] was likewise primarily concerned with the monopoly granted to the applicant.

In the early decision of *De Florez et al* v. *Raynolds et al*, 8 Fed. 434 (C.C.S.D.N.Y. 1880), dealing with the immediate predecessor to R.S. 4887, the court held:

> "We fix the date of November 27, 1862, and not the date of February 20, 1863, because we regard it as the clear intention of the provisions of law limiting the duration of a United States patent, patenting an invention previously patented abroad to the same inventor, to give to the patentee a specified term from the date at which his foreign patent had effect as a foreign patent in his favor." (8 Fed. at page 445)

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[9] R.S. 4887: No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years. [See prior patent statutes: Section 25, 1870; Section 6, 1839; Section 8, 1836.]

The court specifically rejected the contention that the foreign invention must be "accessible to the public" before it could be deemed patented under the statute:

> "This view [in respect to the predecessors of 102(d)] is not necessarily applicable to a case where a foreign patent to one inventor is set up to defeat a United States patent to a different inventor. In such case the manifest intention of the law is that the foreign patent shall apply only as of a date when the invention was published or was accessible to the public, and not as of an earlier date, from which the inventor may have enjoyed the benefit of the foreign patent as a patent. The language of section 16 of the act of 1861, in saying that the 17 years is to run from 'the date of issue,' is a marked departure from the expression, 'date or publication' of the foreign patent, in section 6 of the act of 1839; and in reading the two sections together, full effect must be given to the new expression." (at page 445)

This definitive and clear interpretation established in the *De Florez* case was followed in *Gramme Electric Company* v. *Arnoux & Hochhausen Electric Co.*, 17 Fed. 838 (C.C.S.D.N.Y. 1883), where an Austrian patent was involved. In an effort to avoid the statutory bar, the American patentee contended, like DMRC here, that the description of his corresponding Austrian patent had been kept secret and was not open to the public. Rejecting this contention, the court stated that:

> ". . . however far the Austrian patent might have come short of being a prior public foreign patent sufficient to defeat a patent granted here to another inventor for an invention made after the granting of such prior foreign patent, it is not perceived

> how the question of secrecy or publicity in the foreign patent, granted prior to the granting of the patent here, can affect, under [the predecessor to 102(d)], the question . . . here. The Austrian patent conferred on the patentees an exclusive privilege." (17 Fed. at p. 841)

In *Atlas Glass Co.* v. *Simonds Mfg. Co.*, 102 Fed. 643 (3rd Cir. 1900), the Third Circuit also recognized that "availability to the public" was not required under the predecessor statutes to Section 102(d). The court emphasized that "patented" as used in R.S. 4887 had come to mean "*the exclusive privilege* granted by sovereign authority." The court's discussion, construing the word "patented," and distinguishing it from "open letters" (102 Fed. at 646), makes it abundantly clear that "availability to the public" was not a relevant consideration. The court of appeals held:

> ". . . The true meaning and purpose of the act of congress as expressed in the language used, are accomplished by applying the word 'patented' to having *received the grant of an exclusive privilege* from a foreign sovereign, if such privilege amounts to a substantial monopoly." (102 Fed. at p. 646). (Emphasis added)

The cases decided under the present statute, 35 USC 102(d), all echo the same fundamental principle that an invention is "patented in a foreign country" on the date that the foreign patentee receives whatever exclusive privilege is accorded by the laws of that country, and that it is irrelevant whether or not the disclosure of his patent is made public at that time. See *In re Talbott, supra; G. B. Lewis Co.* v. *Gould Products, Inc.*, 297 F.Supp. 690, 697 (E.D.N.Y., 1968),

aff'd. 436 F.2d 1176 (2nd Cir. 1971); *Ritter* v. *Rohm & Haas Co.*, 271 F.Supp. 313, 317 (S.D.N.Y. 1967).

The only federal court decision cited by the petitioner for the proposition that the word "patented" in section 102(d) has the same meaning as in sections 102(a) and (b) is *American Infra-Red Radiant Co.* v. *Lambert Industries, Inc.*, 360 F.2d 977 (8th Cir. 1966). That case contains *no* such suggestion. Indeed, contrary to the petitioner's contention that the word "patented" can have only one narrow meaning, the court in *American Infra-Red Radiant Co.* recognized:

> "The word 'patent' has *many* general connotations and nuances but must be considered in the context in which it is used by Congress in implementing the Constitutional grant of authority. . . . As used by Congress in the different sections dealing with the establishment of a patent system *we must apply the particular connotation, which is to a certain extent a word of art, that would make effective the Congressional intent.*" (at 993-994)

CONGRESSIONAL POLICY CONSIDERATIONS UNDERLYING SECTION 102(d) DIFFER FROM THOSE UNDERLYING 102(a) AND (b)

While petitioner attempts (p. 13) to blur and confuse the policy considerations underlying section 102 (d), it is indisputably clear that those considerations are significantly different from the policy considerations underlying sections 102(a) and (b). In short, sections (a) and (b) look to prior disclosure by anyone (usually someone other than the United States applicant), while section 102(d) is concerned only with exclusive rights *obtained by the applicant himself* in a foreign country prior to the filing of his United States application.

This basic difference in policy was recognized by this Court in *The Bate Refrigerating Co.* v. *Sulzberger,* 157 U.S. 1, 15 S.Ct. 508, 39 L.Ed. 601 (1895). There, Justice Harlan exhaustively reviewed the prior statutes, the Congressional hearings and legislative history, as well as Patent Office policies and interpretations leading up to the enactment of R.S. 4887, from which section 102(d) is derived.

This decision establishes that the phrase "first patented or caused to be patented by the applicant . . . in a foreign country" must mean those rights and monopoly privileges obtained by the applicant in the foreign country. Referring to R.S. 4887, Justice Harlan stated:

> "The revisers, the House Committee on Patents, and Congress, all had in view the *rights of the inventor* at the time when he was to receive or be debarred from receiving a patent for his invention . . ." (Emphasis added)

Justice Harlan also stated the Congressional concern underlying the time limitation in R.S. 4887, as follows:

> ". . . [I]t is to be remembered—at least it may be assumed that Congress was advised—that action by the Patent Office upon applications for patents was often unduly and purposely delayed by applicants until they could reap the full benefit of the monopoly obtained by them in foreign countries before taking out an American patent." (157 U.S. at page 44)

While the time limitation of 102(d) is now somewhat different, the underlying concern remains the same. Application of this statute is particularly appropriate here, where Chavanoz and DMRC purposely delayed

the filing of the United States applications in an attempt to extend for as long as possible the exclusive rights conferred by a United States patent. [B29, 30] It is exactly this kind of purposeful delay that section 102(d) and its predecessors was intended to limit.

Finally, it should be noted that the decision of the courts below, as well as the decisions relied upon herein, are supported by principles of equity and fairness. For purposes of sections 102(a) and (b), it is not unreasonable to require that the inventions of others be "available to the public" before charging a United States applicant with knowledge of them. On the other hand, for purposes of 102(d), it is not unfair or inequitable to charge a United States applicant with knowledge of the issuance of his own foreign patent and the vesting of the exclusive rights conferred thereby.

To engraft the additional requirement of "availability to the public" onto section 102(d), as petitioner now urges, would clearly be artificial, unrealistic and unnecessary and would do violence to the clear Congressional intent expressed in the statute.

The threat to "innumerable" United States patents foreseen by the petitioner (Petition, pp. 14-15) is nonexistent. The opinions below are clearly limited to section 102(d). Moreover, as demonstrated above, the opinions are in full accord with a long and unbroken line of decisions dating back to 1880. There is certainly no evidence that those decisions ever had the dire consequences suggested by the petitioner.

CONCLUSION

All authorities agree with the result reached in the decisions of the district court and the court of appeals.

The grant of an enforceable exclusive right is the cornerstone of all patent systems. When such grant occurs, the invention is "patented" within the context of 35 USC Section 102(d).

The Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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